

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-32 are pending in the application. Claims 15, 21, and 27 have been amended. New claims 33-35 have been added. The amendment is fully supported by the original disclosure. No new matter has been introduced. Assignee asserts that no prosecution history estoppel should result from the above amendments where the amendments were made to clarify Assignee's claims and/or broaden scope of the amended claims.

Allowable Subject Matter

Assignee thanks the Examiner for indicating that claims 1-14 are allowable.

The Examiner's statements of reasons for allowance are hereby acknowledged by Assignee. Assignee agrees that the claimed subject matter is patentably distinct from the documents cited by the Examiner; however, Assignee takes no position regarding the reasons for allowance presented by the Examiner, other than the positions Assignee may have previously taken during prosecution of the above-referenced patent application. Therefore, the Examiner's reasons for allowance should not be attributed to Assignee as an indication of the basis for Assignees' belief that the claims are patentably distinct. Furthermore, it is respectfully asserted that there may also be additional reasons for patentability of the claimed subject matter not explicitly stated in this record. While in accordance with 37 C.F.R. §1.104(e), a failure by the Assignee to disagree with the Examiner, or file more detailed comments, does not give rise to any implication that the Assignee agrees with or acquiesces in the reasoning of the Examiner,

here, by this document, Assignee is expressly making clear that no such agreement or acquiescence is present.

Claim rejections – 35 USC §102(b)

Claims 15-30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Minnesota Mining and Manufacturing Company (3M) (European Patent No. EP 0 550 038). These rejections are respectfully traversed.

Assignee respectfully submits that 3M does not disclose all of the elements of independent claim 15. The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any conclusion of anticipation includes that:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (See MPEP § 2131.01.)

For example, Examiner has not established that 3M discloses "focusing an image of a first object through a transparent window of an optical scanner, wherein the first object is positioned remote from said transparent window, and wherein the transparent window is capable of supporting a second object thereon; and scanning the image focused through the transparent window to obtain an image of the first object", as recited in claim 15. In the Office Action the Examiner has asserted that:

3M teaches ... Means for focusing (32) an image of a first object (transparency on stage 24) through a transparent window (40) of a scanning body, wherein said first object is positioned remote from said transparent window (40) ... (See page 3 of the Office Action.)

When using the above apparatus, an object is placed on the glass sheet forming stage (24 as is the typical means for operating a overhead projector see column 3 and 4 of the 3M reference).... (See page 4 of the Office Action.)

Assignee cannot agree. Specifically, the Examiner appears to cite both items (40) and items (24) of 3M as the claimed “transparent window”. Where the Examiner cites item (40) of 3M as the claimed “transparent window”, Assignee submits that the Examiner has provided no support from 3M that the item (40) anticipates “wherein the transparent window is capable of supporting a second object thereon” as is claimed. Similarly, where the Examiner cites item (24) of 3M as the claimed “transparent window”, Assignee submits that the Examiner has provided no support from 3M that the item (24) anticipates “wherein the first object is positioned remote from said transparent window” as is claimed. In the absence of the Examiner pointing to such a disclosure in 3M, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that 3M discloses the identical invention as is required for anticipation. See MPEP § 2131.

Likewise, claims 16-32, as well as new claims 33-35 distinguish from 3M on at least the same or similar basis as claim 15.

Additionally, Assignee submits that new claims 33-35 distinguish from 3M on at least the same or similar basis as allowed claim 1.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee’s failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,
Attorney for Assignee

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